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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


Application No.: 10/823,435
Applicant: GIROUX et al.
Filed: April 12, 2004
Art Unit: 1615
Examiner: Unknown
Title: MEDICAL DEVICES EMPLOYING POLYMERS
OF SPECIFIC CHARACTERISTICS AND THEIR
USES

Docket No.: 04271500
Customer No.: 26565

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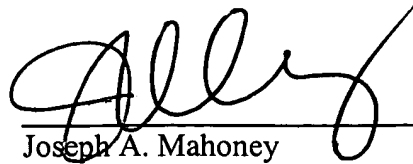
TRANSMITTAL LETTER

Dear Sir:

Enclosed herewith are the following for the above-captioned application:

1. Renewed Petition Under 37 C.F.R. 1.78(A)(3) To Accept An Unintentionally Delayed Claim Under 35 U.S.C. 120, 121, Or 365(C) For The Benefit Of A Filed Prior Copending Application;
2. Copy of Decision on Petition dated January 27, 2005;
3. Preliminary Amendment A;
4. Supplemental Application Data Sheet;
5. Copy of Petition Under 37 C.F.R. 1.78(A)(3) filed on November 18, 2004; and
6. Return receipt postcard.

Respectfully submitted,



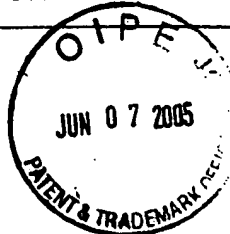
Joseph A. Mahoney
Reg. No. 38,956

Date: June 7, 2005

CUSTOMER NO. 26565
MAYER, BROWN, ROWE & MAW LLP
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Chicago, Illinois 60690-2828
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UNITED STATES PATENT AND TRADEMARK OFFICE



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MAYER, BROWN, ROWE & MAW, LLP
190 SOUTH LASALLE STREET
CHICAGO, IL 60603-3441

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OFFICE OF PETITIONS

In re Application of
Giroux et al.
Application No. 10/823,435
Filed: April 12, 2004
Attorney Docket No. 04271500

:
:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed November 18, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of prior-filed nonprovisional Application No. 10/716,577, filed November 18, 2003.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The petition filed November 18, 2004 fails to state the relationship of Application No. 10/716,577, filed November 18, 2003, to the instant application.

It is also unclear whether or not the petitioner wishes to claim benefit of PCT Application No. PCT/US03/36925. Although the box was left unchecked on the instant petition, a declaration filed on

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November 29, 2004, includes a reference to the above-noted PCT application, which was also lacking a relationship statement to the instant application.

Further, the amendment submitted concurrently with the instant petition as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the instant petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim, (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct submit must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

In view of the above, the amendment to add a priority claim to the first line of the specification, which is physically embedded in the instant petition, is not acceptable.

Accordingly, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute amendment¹ in compliance with the aforementioned rules and stating the relationship of the prior-filed application(s) to the instant application is required.

Further correspondence with respect to this matter should be addressed as follows:

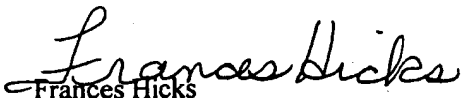
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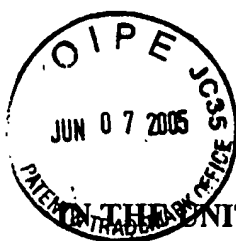
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By fax: (703) 872-9306
 ATTN: Office of Petitions

Any questions concerning this matter may be directed Paralegal Liana Chase at (571) 272-3206.


Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ Note 37 CFR 1.121



UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/823,435
Applicant: UHRICH et al.
Filed: April 12, 2004
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Examiner: Unknownwn
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CHARACTERISTICS AND THEIR
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Date of Deposit: November 18, 2004

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Tim Hubalik

Docket No.: 04271500
Customer No.: 26565

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**PETITION UNDER 37 C.F.R. 1.78(A)(3) TO ACCEPT AN UNINTENTIONALLY
DELAYED CLAIM UNDER 35 U.S.C. 120, 121, OR 365(C) FOR THE BENEFIT OF A
FILED PRIOR COPENDING APPLICATION**

Dear Sir:

Applicants hereby petition, in accordance with § 1.78(a)(3), to claim the benefit, for this
application under 35 U.S.C. ☒ 120 ☐ 121 ☐ 365(c),

☒ of prior copending nonprovisional application no.: 10/716,577

filing date: November 18, 2003

☐ of international application designating the U.S. no.: PCT/US03/36925

international filing date: November 18, 2003

Applicants state that the entire delay between the date the claim for the benefit of the earlier application was due under paragraph (a)(2)(ii) of 37 C.F.R. § 1.78 and the date this claim is filed was unintentional.

The surcharge fee set forth in § 1.17(t) required by 37 C.F.R. 1.55(c)(1), is paid as follows:

- ☒ A check in the amount of \$1,370.00 is attached.
- ☒ Authorization is hereby made to charge any additional fees required by this paper or credit any overpayment o Deposit Account No. 13-0019.

Respectfully submitted,



David B. Fournier
Reg. No. 51,696

Date: November 18, 2004

CUSTOMER NO. 26565
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Chicago, Illinois 60690-2828
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CHICAGO, ILLINOIS 60603



Attorney: JAM/ATB/DBF
Client: Polymerix Corporation

PATENT
Attorney Docket: 04271500

Application No.: 10/823435
Filed: April 12, 2004
Applicant: UHRICH et al.
Title: MEDICAL DEVICES EMPLOYING POLYMERS OF SPECIFIC
CHARACTERISTICS AND THEIR USES

Enclosed: • Petition Under 37 CFR 1.78(a)(3) to Accept an Unintentionally Delayed Claim
Under 35 USC 120, 121, Or 365(c) For the Benefit of a Filed Prior Copending
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• \$1,370.00 check; and
• Return receipt postcard.

EXPRESS MAIL NO. EV548616325US

MAILING DATE: November 18, 2004

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